



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/145,987	09/03/1998	YUKIKO NAKANISHI	2224-0142P	6638

2292 7590 12/28/2005

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
----------

MAIER, LEIGH C

ART UNIT	PAPER NUMBER
----------	--------------

1623

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/145,987	NAKANISHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Leigh C. Maier	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9-13,18,20,23 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,13,27,28 and 31 is/are allowed.
- 6) ☒ Claim(s) 9-12,18,20,23,29,30,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2005 has been entered.

Claims 2-8 and 26 have been canceled. Claims 1, 9-11, and 18 are amended. Claims 28-33 are newly added. Any rejection or objection not expressly repeated has been withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The declaration under 37 CFR 1.132 filed September 2, 2005 is sufficient to overcome the rejection of claims 1, 11 and dependents thereof based upon 35 USC § 102 (Uenishi et al).

Dr. Shibata's declaration demonstrates the differences in the products prepared according to the instant invention compared with the teaching of Uenishi. The product according to Uenishi provides a product having a pH outside the recited range, higher free metal ion content and lower stability. The higher stability of the instant product runs counter to the teaching of Uenishi. One of ordinary skill would not be motivated to prepare a product having less acid and higher pH, as required in the instant invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-12, 18, 20, 23, 29, 30, 32, and 33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicant, at the time the application was filed, had possession of the claimed invention.

Claims 11 and 18 comprise a section (iiib) which recites a limitation wherein "...the total content of the alkali metal and alkaline earth metal in 1 gram of cellulose acetate is more than  $5.5 \times 10^{-6}$  equivalent ...". The examiner finds no support in the specification for this limitation.

***Claim Rejections - 35 USC § 102***

Claims 9, 10, 18, 30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Uenishi et al (JP 2-252607).

The independent claim (18) appears to be parallel in construction with claim 11. However, claim 18 does not recite the limitation regarding the pH of the cellulose acetate flake used to prepare the dope. This is the limitation that overcomes the art of record with respect to the cellulose acetate, per se.

The reference discloses an organic solution, or dope, of the cellulose acetate prepared with the addition of citric acid, as discussed in previous Office actions. According to the data in

Art Unit: 1623

Dr. Shibata's declaration, the product prepared according to Uenishi would comprise a metal ion content consistent with feature (iiia).

The reference does not disclose the source of the cellulose used to prepare the cellulose acetate. However, as Applicant admits, the cost of using linter pulp is quite high, so it would appear more likely than not that a wood pulp is used. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Claims 9, 10, 18, 20, 23, 30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Yabe et al (GB 2101136).

Yabe teaches the preparation of a number of cellulose triacetates having a range of metal ions. See the table at the bottom of page 2. These metal ion contents (in ppm) appear to be consistent with the range recited in feature (iiia). Compare with Applicant's comparative example at page 32 of the instant specification. The reference further discloses the preparation of a dope comprising methylene chloride and the casting of a film. See text of page 3 and reference claims. As discussed above, there is not description of the origin of the cellulose, but it would appear more likely than not that it was prepared from a wood pulp.

Art Unit: 1623

***Allowable Subject Matter***

Claims 1, 13, 27, 28, and 31 are allowed. Claims 11, 12, 29, and 32 are subject to a new matter rejection, as set forth above but appear to be free of the art. The following is a statement of reasons for the indication of allowable subject matter: The art of record is overcome by the showing in the submitted declaration, as discussed above.

Applicant might consider canceling claim 18, and substituting a claim along the lines of "A dope comprising the cellulose acetate composition *according to claim 11*, and further comprising an organic solvent" or some similar amendment to claim 18. Such a claim dependents of record would be allowable. With regard to claim 11, Applicant may (1) cancel section (iiib); (2) amend it so that all limitations have support in the <sup>specification</sup> ~~limitation~~, or (3) point out the support that the examiner overlooked.

LCM

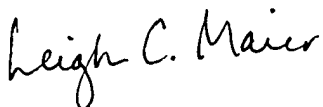
Art Unit: 1623

*Examiner's hours, phone & fax numbers*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Maier whose telephone number is (571) 272-0656. The examiner can normally be reached on Tuesday, Thursday, and Friday 7:00 to 3:30 (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anna Jiang (571) 272-0627, may be contacted. The fax number for Group 1600, Art Unit 1623 is (571) 273-8300.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov> Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



Leigh C. Maier  
Patent Examiner  
December 19, 2005